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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,568	08/05/2003	Susan G. O'Connell	OCO-001	7173

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EXAMINER	
MENDIRATTA, VISHU K	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/633,568	O'CONNELL, SUSAN G.	
	Examiner	Art Unit	
	Vishu K Mendiratta	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-13 and 15-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-13 and 15-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,4,5,8,10 rejected under 35 U.S.C. 102 (a) as being anticipated by Elaine Roberts (GB2258411A).

Claim 1: Roberts teaches a board game (9) having game pieces (44-49), game spaces of different categories (29), category question cards (54), and photographs (36). Broadly speaking photographs having famous faces (36) are being interpreted as family pictures.

Roberts further teaches a housing (Fig.2) that can be broadly and reasonably interpreted as an album. Further storing family photographs is intended use of the apparatus in the claim and do not further limit the apparatus.

Applicant might argue that a housing is not a photo album. Examiner takes the position that according to Webster an album is a container for card like objects.

Claims 4,5: Rules for playing a game do not further limit an apparatus claim.

Claim 8: Categories being identified by colors (Page 3 lines 4-5, reference character 52).

Claim 10: Answer sheet (43,54).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-5,8,10 rejected under 35 U.S.C. 103(a) as obvious over Selby (5280914) in view of Ex.Parte Breslow 192 USPQ 431.

Selby teaches a board game (10) having game pieces (12), game spaces of different categories (14,16,18), category question cards (28,30,32), and photographs (25). Broadly speaking photographs having famous faces (25) are being interpreted as family pictures.

Selby teaches all limitations except that it does not expressly indicate photos being "family photos".

Selby further teaches a card retainers (38,39,40) that can be broadly and reasonably interpreted as an album. Further storing family photographs is intended use of the apparatus in the claim and do not further limit the apparatus.

The only difference between cited photos of famous persons and applicant's photos of family persons resides in meaning and information and the difference is not considered patentable Ex. Parte Breslow. The photo being a family photo or any other person's photo does not change the game.

In order to make the game attractive to family members, it would have been obvious to use family photos. One of ordinary skill in art at the time the invention was made would

have suggested modifying cited photos to include family photos to make the game attractive for family members.

Claim 2: Selby teaches all limitations except that it does not expressly teach applicant's claimed categories.

The only difference between cited categories and applicant's categories resides in meaning and information conveyed by the printed matter and the difference is not considered patentable Ex. Parte Breslow. The category difference between identifying a picture of a family member, or identifying a picture of any famous person, does not change the game.

In order to make the game attractive to family members, it would have been obvious to use categories in family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying cited categories to include categories of family photos to make the game attractive for family members.

Claims 3-5: Rules for playing a game do not further limit an apparatus claim

Claim 8: Categories being identified by colors (indicia on categories).

Claim 10: Answer sheet (26).

5. Claims 1-5,8,10 rejected under 35 U.S.C. 103(a) as obvious over Elaine Roberts in view of Ex.Parte Breslow 192 USPQ 431.

Claim 1: Roberts teaches a board game (9) having game pieces (44-49), game spaces of different categories (29), category question cards (54), and photographs (36).

Broadly speaking photographs having famous faces (36) are being interpreted as family pictures.

Roberts teaches all limitations except that it does not expressly indicate photos being "family photos". Roberts further teaches a housing (Fig.2) that can be broadly and reasonably interpreted as an album. Further storing family photographs is intended use of the apparatus in the claim and do not further limit the apparatus. Applicant might argue that a housing is not a photo album. Examiner takes the position that according to Webster an album is a container for card like objects.

The only difference between cited photos of famous persons and applicant's photos of family persons resides in meaning and information and the difference is not considered patentable Ex. Parte Breslow. The photo being a family photo or any other person's photo does not change the game.

In order to make the game attractive to family members, it would have been obvious to use family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying cited photos to include family photos to make the game attractive for family members.

Claim 2: Roberts teaches all limitations except that it does not expressly teach applicant's claimed categories.

Roberts however does indicate at possibility of including other categories (page 5, last line). The only difference between cited categories and applicant's categories resides in meaning and information conveyed by the printed matter and the difference is not considered patentable Ex. Parte Breslow. The category difference between identifying a

picture of a family member, or identifying a picture of any famous person, does not change the game.

In order to make the game attractive to family members, it would have been obvious to use categories in family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying cited categories to include categories of family photos to make the game attractive for family members.

Claims 3-5: Rules for playing a game do not further limit an apparatus claim

Claim 8: Categories being identified by colors (Page 3 lines 4-5, reference character 52).

Claim 10: Answer sheet (43,54).

6. Claims 1-5,8,10,11-15,18,20 rejected under 35 U.S.C. 103(a) as obvious over Elaine Roberts in view of Tweedy (US2002/0195772A1).

Claim 1: Roberts teaches a board game (9) having game pieces (44-49), game spaces of different categories (29), category question cards (54), and photographs (36). Broadly speaking photographs having famous faces (36) are being interpreted as family pictures.

Roberts teaches all limitations except that it does not expressly indicate photos being "family photos". Roberts further teaches a housing (Fig.2) that can be broadly and reasonably interpreted as an album. Further storing family photographs is intended use of the apparatus in the claim and do not further limit the apparatus. Applicant might argue that a housing is not a photo album. Examiner takes the position that according to Webster an album is a container for card like objects.

Tweedy teaches using family photos (abstract)

The only difference between cited photos of famous persons and applicant's photos of family persons resides in meaning and information and the difference is not considered patentable. The photo being a family photo or any other person's photo does not change the game.

In order to make the game attractive to family members, it would have been obvious to use family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying cited photos to include family photos to make the game attractive for family members.

Newly added limitation "step of preparing cards" is being interpreted as method of making a game and do not further limit the claimed method of playing a game. How cards are made does not change the way they are used in game.

Claim 2: Roberts teaches all limitations except that it does not expressly teach applicant's claimed categories.

Roberts however does indicate at possibility of including other categories (page 5, last line). The only difference between cited photos of famous persons and applicant's photos of family persons resides in meaning and information and the difference is not considered patentable. The photo being a family photo or any other person's photo does not change the game.

The category difference between identifying a picture of a family member or identifying a picture of any famous person does not change the game.

In order to make the game attractive to family members, it would have been obvious to use categories in family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying cited categories to include categories of family photos to make the game attractive for family members.

Claims 3-5: Rules for playing a game do not further limit an apparatus claim

Claim 8: Categories being identified by colors (Page 3 lines 4-5, reference character 52).

Claim 10: Answer sheet (43,54).

7. Claims 11-15,18,20 rejected under 35 U.S.C. 103(a) as obvious over Elaine Roberts in view of Tweedy (US2002/0195772A1) and further in view of Ruff (5860652).

Claim 11: Roberts teaches a board game (9) having game pieces (44-49), game spaces of different categories (29), category question cards (54), and photographs (36). Broadly speaking photographs having famous faces (36) are being interpreted as family pictures.

Roberts teaches all limitations except that it does not expressly indicate photos being "collected and organized from family photos".

Tweedy teaches collecting and organizing family photos (abstract lines 1-4)

The only difference between collecting photos of famous persons in Roberts and applicant's photos of family persons resides in meaning and information and the difference is not considered patentable. The photo being a family photo or any other person's photo does not change the game.

In order to make the game attractive to family members, it would have been obvious to collect family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying Robert's photos to include family photos to make the game attractive for family members.

Newly added limitation "step of preparing cards" is being interpreted as method of making a game and do not further limit the claimed method of playing a game. How cards are made does not change the way they are used in game.

However if the newly added limitation is meant to claim a method step of playing a game wherein players during game conceive and write questions on cards, the combination of Roberts and Tweedy does not appear to teach that limitation.

Ruff teaches a method of playing a board game having a method step of players writing questions on cards (abstract, claim 1).

Whereas preprinted cards are generic and lack personalized/customized questions and players lose their interest in playing the game after using them a few times. Ruff allows blank cards to be written with customized questions for creating and maintaining interest in the game.

In order to maintain interest in the game, it would have been obvious to allow players to write personalized/customized questions on cards.

One of ordinary skill in art at the time the invention was made would have suggested modifying Robert and Tweedy combination to allowing a method step of writing their own questions on cards.

Claims 12-15: Roberts teaches all limitations except that it does not expressly teach applicant's claimed categories.

Roberts however does indicate at possibility of including other categories (page 5, last line). The only difference between cited photos of famous persons and applicant's photos of family persons resides in meaning and information and the difference is not considered patentable. The photo being a family photo or any other person's photo does not change the game.

The category difference between identifying a picture of a family member or identifying a picture of any famous person does not change the game.

In order to make the game attractive to family members, it would have been obvious to use categories in family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying cited categories to include categories of family photos to make the game attractive for family members.

Claim 18: Categories being identified by colors (Page 3 lines 4-5, reference character 52) by Roberts.

Claim 20: Answer sheet (43,54) taught by Roberts.

8. Claims 6,7,16,17 rejected under 35 U.S.C. 103(a) as obvious over Elaine Roberts in view of Bouchal (4637799).

Roberts teaches all limitations except that it does not teach cards or pictures in the shape of an album.

Bouchal teaches a game for identifying pictures and provides an album (18:15-27).

Albums provide a storyline of photos when arranged logically. Such arrangement provides amusement and further enhances the entertainment value of the game for participants. In order to make the game amusing and more entertaining, it would have been obvious to provide photos in a fixed arrangement in an album.

The means for identifying family in the photograph is broadly interpreted by female pictures for women and male pictures for men.

9. Claims 9,19 rejected under 35 U.S.C. 103(a) as obvious over Elaine Roberts in view of Olsen (6672590).

Roberts teaches all limitations except that it does not teach a "lose a turn card".

Olsen teaches a "lose a turn card" (80). Board game art recognizes "lose a turn" card as penalty cards in order to make the game challenging.

One of ordinary skill in art at the time the invention was made would have used such a step for making the game more challenging.

10. Claim 11 rejected under 35 U.S.C. 103(a) as obvious over Selby in view of Tweedy (US2002/0195772A1).

Claim 11: Selby teaches a board game (10) having game pieces (12), game spaces of different categories (14,16,18), category question cards (28,30,32), and photographs (25). Broadly speaking photographs having famous faces (25) are being interpreted as family pictures.

Selby teaches all limitations except that it does not expressly indicate photos being "collected and organized from family photos".

Tweedy teaches collecting and organizing family photos (abstract lines 1-4).

The only difference between collecting photos of famous persons in Roberts and applicant's photos of family persons resides in meaning and information and the difference is not considered patentable. The photo being a family photo or any other person's photo does not change the game.

In order to make the game attractive to family members, it would have been obvious to collect family photos. One of ordinary skill in art at the time the invention was made would have suggested modifying Selby's photos to include family photos to make the game attractive for family members.

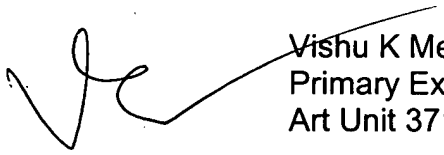
Response to Arguments

11. Applicant's arguments filed 2/11/05 have been fully considered but they are not persuasive. ***. Roberts teaches a housing (Fig.2) that can be broadly and reasonably interpreted as an album. Further storing family photographs is intended use of the apparatus in the claim and do not further limit the apparatus. Applicant might argue that a housing is not a photo album. Examiner takes the position that according to Webster an album is a container for card like objects. Placing photos or any other card like object is only an intended use of the container. In that regard Roberts uses the housing as an album. Roberts' housing is fully capable of functioning as an album.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K Mendiratta
Primary Examiner
Art Unit 3711

VKm
May 10, 2005